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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,562	12/14/2001	Mats Larhed	1209-0129P	5761

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EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 08/25/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/014,562

Applicant(s)

LARHED ET AL.

Examiner

My-Chau T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 17-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,3-15 and 17-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

1. Applicant's amendment filed 6/6/03 in Paper No. 9 is acknowledged and entered. Claims 2 and 16 are canceled by the amendment. Claims 1, 3, 5-9, 15, 17, and 19 are amended by the amendment.

2. Claims 1, 3-15, and 17-36 are pending.

3. Upon reconsideration of the restriction and election of species in view of the amended claims 1, 3, 15, 17, and 19, the previous restriction is withdrawn. Applicant traversal of the restriction and election of species are fully considered but are moot in view of the new restriction as set forth below:

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 5-9, 11-14, 18, 20-27, 31-36, drawn to a method for performing a one-pot organic reaction with a non-catalysing solid CO releasing metal carbonyl compound, classified in class 423, subclass 417.
- II. Claims 3-6, 10, and 28-30, drawn to a method for performing a one-pot organic reaction with a non-catalysing CO releasing formamide compound, classified in class 423, subclass 365.

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- III. Claims 15-16, 18, and 35-36, drawn to a method of preparing chemical libraries with a non-catalysing solid CO releasing metal carbonyl compound, classified in class 436, subclass 145.
- IV. Claims 17, drawn to a method of preparing chemical libraries with a non-catalysing liquid CO releasing formamide compound, classified in class 435, subclass 3.
- V. Claim 19 is drawn to a kit, classified in class 435, subclass 287.1.

The inventions are distinct, each from the other because of the following reasons:

5. Inventions of Groups I, II, III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions (methods) require different reagents that have different functions and different effects and would produced different products/results.

The method of Group I includes the combination of reactants comprising a carbon monoxide reactant and a non-catalysing solid CO releasing metal carbonyl compound is not required by the claims of Groups II-IV. The method of Group II includes the combination of reactants comprising a carbon monoxide reactant and a non-catalysing CO releasing formamide compound is not required by the claims of Groups I, and III-IV. The method of Group III includes a reactant comprising a non-catalysing solid CO releasing metal carbonyl compound is not required by the claims of Groups I-II, and IV. The method of Group IV includes a reactant

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comprising a non-catalysing liquid CO releasing formamide compound is not required by the claims of Groups I-II, and III.

6. Inventions of Group I (process) and Group V (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as the method of substrate preparation for biochip or the method of decoding a message. This restriction requirement is also applicable with each the methods of Groups II-IV. ✓

7. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group III would involve a determination of the patentability of a method for performing a one-pot organic reaction with the combination of reactants comprised of a carbon monoxide reactant and a non-catalysing CO releasing formamide compound (independent of its use) while a patentability determination for Group IV would involve a consideration of the patentability of a method of preparing chemical

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libraries with a non-catalysing liquid CO releasing formamide compound. These considerations are very different in nature.

Even though some of the groups are classified in the same class/subclass, this has no effect on the non-patent literature search. Different groups would require completely different searches in non-patent databases, and there is no exception that the searches would be co-extensive.

8. This application contains claims directed to the following patentably distinct species of the claimed invention:

9. If applicants elect the invention of Group I, applicants are required to further elect *one* species from *each* group below:

- a. A **single** specific compound of formula I.
- b. A **single** specific metal catalyst.
- c. A **single** specific non-metal substrate.
- d. A **single** specific energy source.

The species are distinct, each from the other, because each species have different chemical structure and/or physiochemical properties and would be capable of separate manufacture and/or use; and would necessitate different and separately burdensome manual and computer bibliographic and structure searches in both patent and non-patent areas.

For this response to be complete and for search purposes, applicants should provide the chemical structure of elected compounds or composition or species, wherein each specific

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formula substituents of each of the above identified elected species are defined either by picture, or by expressing the species in terms of the variables of the formula.

10. If applicants elect the invention of Group II, applicants are required to further elect *one* species from *each* group below:

- a. A **single** specific compound of formula II.
- b. A **single** specific metal catalyst.
- c. A **single** specific non-metal substrate.
- d. A **single** specific energy source.

The species are distinct, each from the other, because each species have different chemical structure and/or physiochemical properties and would be capable of separate manufacture and/or use; and would necessitate different and separately burdensome manual and computer bibliographic and structure searches in both patent and non-patent areas.

For this response to be complete and for search purposes, applicants should provide the chemical structure of elected compounds or composition or species, wherein each specific formula substituents of each of the above identified elected species are defined either by picture, or by expressing the species in terms of the variables of the formula.

11. If applicants elect the invention of Group III, applicants are required to further elect *one* species from *each* group below:

- a. A **single** specific compound of formula I.
- b. A **single** specific metal catalyst.
- c. A **single** specific non-metal substrate.
- d. A **single** specific energy source.

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The species are distinct, each from the other, because each species have different chemical structure and/or physiochemical properties and would be capable of separate manufacture and/or use; and would necessitate different and separately burdensome manual and computer bibliographic and structure searches in both patent and non-patent areas.

For this response to be complete and for search purposes, applicants should provide the chemical structure of elected compounds or composition or species, wherein each specific formula substituents of each of the above identified elected species are defined either by picture, or by expressing the species in terms of the variables of the formula.

12. If applicants elect the invention of Group IV, applicants are required to further elect ***one*** species from ***each*** group below:

- a. A **single** specific compound of formula II.
- b. A **single** specific metal catalyst.
- c. A **single** specific non-metal substrate.
- d. A **single** specific energy source.

The species are distinct, each from the other, because each species have different chemical structure and/or physiochemical properties and would be capable of separate manufacture and/or use; and would necessitate different and separately burdensome manual and computer bibliographic and structure searches in both patent and non-patent areas.

For this response to be complete and for search purposes, applicants should provide the chemical structure of elected compounds or composition or species, wherein each specific formula substituents of each of the above identified elected species are defined either by picture, or by expressing the species in terms of the variables of the formula.

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13. If applicants elect the invention of Group V, applicants are required to further elect the following species:

- a. A non-catalyzing solid or liquid CO releasing compound. If applicant elects a solid CO releasing compound, applicant is requested to elect a **single** specific compound.

The species are distinct, each from the other, because each species have different chemical structure and/or physiochemical properties and would be capable of separate manufacture and/or use; and would necessitate different and separately burdensome manual and computer bibliographic and structure searches in both patent and non-patent areas.

For this response to be complete and for search purposes, applicants should provide the chemical structure of elected compounds or composition or species, wherein each specific formula substituents of each of the above identified elected species are defined either by picture, or by expressing the species in terms of the variables of the formula.

14. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

15. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

16. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

17. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999.

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The examiner is on *Increased Flex Schedule* and can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

mct
August 21, 2003


PADMASHRI PONNALURI
PRIMARY EXAMINER